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ELMORE PATENT LAW GROUP, PC
515 Groton Road
Unit 1R
Westford MA 01886

MAILED

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OFFICE OF PETITIONS

In re Patent No. 7,550,283 : DECISION ON REQUEST
Holland et al. : FOR
Application No. 10/821,640 : RECONSIDERATION OF
Issue Date: June 23, 2009 : PATENT TERM ADJUSTMENT
Filed: April 9, 2004 : and
Atty Docket No.4010.3002 US1 : NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the petition filed on June 23, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand, two hundred and thirty-four (1234) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand and sixty-seven (1067) days is **GRANTED to the extent indicated herein.**

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged.

Patentee disputes the following: the delay associated with the mailing of the restriction requirement on September 21, 2006; the delay associated with the submission of the issue fee payment on May 11, 2009; and the delay associated with the Office taking in excess of three years to issue the patent.

With respect to the delay associated with the mailing of the restriction requirement on September 21, 2006, Patentees have

argued that the consideration of a restriction requirement as a "first action on the merits" is "inconsistent with the long standing interpretation of this phrase as being the first action resulting from examination of the claims." This argument will not be considered on the merits.

On February 9, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 325 days. This determination included calculation of the disputed 469 days for Office delay associated with the mailing of the restriction requirement. PALM records indicate that the issue fee payment was received in the Office on May 11, 2009. No filing of an application for patent term adjustment under 37 CFR 1.705(b) preceded the payment of the issue fee. The period for filing an application for patent term adjustment requesting reconsideration of the initial determination of patent term adjustment at the time of mailing of the notice of allowance ended (Monday) May 11, 2009. Accordingly, to the extent the present application requests reconsideration of the 469 day adjustment, it is appropriate to dismiss this petition as untimely filed.

With respect to the delay associated with the submission of the issue fee payment on May 11, 2009, Rule 1.704(b) sets forth, in pertinent part:

an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

A notice of allowance was mailed on February 9, 2009, and the issue fee was not received until May 11, 2009, which is three months and two days later. As such, a reduction of two days was assessed. Patentees have argued that this is improper, as May

9, 2009 fell on a Saturday. However, Petitioner will note that 35 U.S.C. 154(b)(2)(C)(ii)¹ does not require that a reply be filed in the Office within its three (3) month grace period, but simply specifies that there is a patent term adjustment reduction if a reply is not filed within this three (3) month period. Therefore, the "carry-over" provisions of 35 U.S.C. § 21(b)² does not apply to the three (3) month period in 35 U.S.C. 154(b)(2)(C)(ii). The period of reduction of 2 days is warranted and will not be removed.

With respect to the delay associated with the failure of the Office to issue the patent within 3 years, the patent issued 3 years and 806 days after its filing date. However, it is noted that the time consumed by the appellate review is excluded from the period of B-delay. See 35 U.S.C. § 154(b)(1)(B)(ii). Therefore, the 32-day period beginning on January 9, 2009, the date of filing of a notice of appeal and ending on February 9, 2009, the date of mailing of a subsequent notice of allowance is excluded from the period of B-delay. Moreover, the days of "A" delay beginning on January 11, 2009 and ending on February 9, 2009 overlap with the period of B-delay. As such, considering the exclusion of 32 days and the overlap of 30 days, the period of "B" delay is 744 (806 - (32 + 30)) days and thus, the revised patent term adjustment is 1067 days. (The period of 307 days of "B" delay entered at issuance is being removed and a period of 744 days of "B" delay is entered).

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

¹ "With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant."

² "When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day."

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand and sixty-seven (1067) days**.

Telephone inquiries specific to this matter should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with a large loop at the end.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,550,283 B2

DATED : June 23, 2009

DRAFT

INVENTOR(S) : Holland et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 630 days

Delete the phrase “by 630 days” and insert – by 1067 days--